

REMARKS

Claim Status

Claims 1-20 are currently pending in this application and have been rejected. Claims 1, 3, 7 and 9 have been amended. Applicants submit no new matter has been entered by way of this amendment.

Double Patenting

Claims 1, 2 and 7 have been rejected under the judicially created doctrine obviousness-type double patenting as being unpatentable over claims 1 and 15 of U.S. Patent No. 6,717,959. (See Office Action, ¶¶1 and 2, page 2.)

Under this doctrine, a patent is rendered invalid when it is merely an obvious variation of an invention disclosed and claimed in an earlier patent that has common inventorship and/or ownership. See Georgia-Pacific Corp. v. United States Gypsum Co., 195 F.3d 1322, 1326 (Fed. Cir. 1999).

Claim 1 of the issued patent reads as follows:

1. A method for automatically configuring call appearance values from message exchanges over a D channel in an ISDN BRI circuit, said method comprising:

- (a) generating a first call from a first Primary Directory Number (PDN) to a second PDN in the same BRI circuit;
- (b) monitoring the message exchange on the D channel for first Call Appearance information for said first PDN;
- (c) obtaining said first Call Appearance information for said first PDN from the D channel; and
- (d) configuring said first PDN with said first Call Appearance information.

Claims 1 and 2 of the instant application(as amended), read as follows:

1. A method for automatically identifying Call Appearance values from a message exchange over a D channel in a PBX device coupled to multiple ISDN Basic Rate Interfaces (BRIs), said method, for each BRI coupled to the PBX device, comprising the steps of:

- (a) generating a first call from a first Primary Directory Number (PDN1) to a second Primary Directory Number (PDN2) within a single BRI circuit; and
- (b) monitoring the message exchange on the D channel to obtain first Call Appearance information.

2. A method according to claim 1 further comprising the step of:

- (c) obtaining said first Call Appearance information from the D channel.

Similar analysis has been undertaken with respect to claim 7 of the instant application and claim 15 of the issued patent.

The rejection of pending claims 1 and 2 are based upon the following statement, with a similar statement for pending claim 7:

[T]he combination of claims 1 and 2 of the co-pending application are the same as claim 1 of the patent *except that the first PDN with the Call Appearance Information is not being configured.*
(See ¶2, page 2, of the Office Action; emphasis added)

The Examiner essentially admits that an element which is the focus of one claim (claim 1 of the issued patent) which is directed to “[a] method for automatically configuring call appearance values from message exchanges over a D channel in an ISDN BRI circuit,” is completely lacking in pending claims 1/ 2 which are directed to “[a] method for automatically identifying Call Appearance values from a message exchange over a D channel in a PBX device coupled to multiple ISDN Basic Rate Interfaces (BRIs).”

Thus, as the basis for these rejections, the Examiner has apparently characterized a claim for “a method for automatically identifying Call Appearance values from a message exchange over a D channel in a PBX device coupled to multiple ISDN Basic Rate Interfaces (BRIs)” which does not require configuring a first PDN with Call Appearance information and monitors for Call Appearance information (claim 1) and obtains such Call Appearance information (claim 2), as merely being an obvious variant over a claim for “a method for automatically configuring call appearance values from message exchanges over a D channel in an ISDN BRI circuit” and which affirmatively recites “configuring said first PDN with said first Call Appearance information”.

Applicants respectfully submit that the claims in the issued patent and those of the instant application recite distinct features in combination and are drawn to independent and

distinct inventions that are not properly rejected under the judicially created doctrine obviousness-type double patenting.

Nonetheless, in order to expedite prosecution, Applicants herewith submit a Terminal Disclaimer disclaiming the term of any patent issuing from this application in view of issued patent USP 6,717,959.

Accordingly, Applicants respectfully request that the double-patenting rejection be withdrawn.

Claim Rejections – 35 U.S.C. § 112

Claims 1-20 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. (See Office Action, ¶¶3-5, page 3.)

Specifically, claims 1 and 7 have been rejected because they recite the phrase “the same BRI circuit,” which lacks antecedent basis (claims 2-6 and 8-20 have been rejected as being dependent on rejected independent claims 1 and 7).

Applicants submit that the claims 1 and 7 as amended overcome or otherwise render moot the stated rejection. Accordingly, Applicants request withdrawal of the rejection of claims 1-20 under 35 U.S.C. §112.

Specification Objection/ Request for Information under 37 C.F.R. § 1.105

The amendment filed on February 6, 2004 has been objected to under 35 U.S.C. §132 because it is alleged to introduce new matter into the disclosure. (See Office Action, ¶6, page 3.) Applicants respectfully disagree with this assertion.

The amendment introduced in the February 6, 2004 paper sought to correct an inadvertent typographical error in the specification as filed, namely, to correctly identify the year of publication of document SR-4620, Issue 1 of the 1999 Version of the Bellcore National ISDN BRI Terminal Equipment (TE) Generic Guidelines.

Submitted herewith is information taken from the National ISDN Council website (<http://www.nationalisdncouncil.com/platform.htm>) which maintains documents defining the National ISDN Feature Platform. As will be appreciated, there is only one such document SR-4620. As is shown on page 2 of the document, SR-4620, Issue 1 was published in December 1998, not 1996 as inadvertently indicated in the specification as filed. Accordingly the specification was amended to indicated 1998, the correct publication date.

Further, in order to comply with the Examiner's Request for Information under 37 C.F.R. § 1.105, a copy of the document SR-4620 is submitted herewith. (See Office Action, ¶¶7-8, pages 4-5.)

Accordingly, the correction of the inadvertent error in the year of publication of a reference discussed in the specification does not, as is evident, add new matter. Applicants respectfully request that this objection be withdrawn.

Claim Rejections – 35 U.S.C. § 102

Claims 1, 2, 7, 8, 13 and 15 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Sasano, et al. (USP 5,200,994) ("Sasano"). (See Office Action, ¶¶9-10, page 5.)

Applicants respectfully traverse this rejection and submit that the independent claims 1 and 7, as well as the claims directly or indirectly dependent therefrom, are patentably distinct from the cited reference.

Independent claim 1 recites, *inter alia*, "A method for automatically identifying Call Appearance values...comprising... generating a first call from a first Primary Directory Number (PDN1) to a second Primary Directory Number (PDN2) within a single BRI circuit...." Applicants submit that the system disclosed in Sasano does not disclose, teach or suggest generating a first call from a first Primary Directory Number to a second Primary Directory Number within a single BRI circuit.

Instead, Sasano discloses a communication terminal apparatus with party identification features. More specifically, Sasano discloses a system in which a user manually enters user information via a keypad during a registration process, creating a roster of potential terminal users stored in the terminal. The user information may include a telephone number, a sub-address and a corresponding name for each entry. Upon receiving an incoming call, the system analyzes the incoming call data to determine whether a caller has input a sub-address that corresponds to one of the data entries stored in the terminal. If a matching sub-address is found, the system is capable of displaying the corresponding caller information extracted from the stored data entry on a display unit associated with the terminal. (See, Sasano, Col. 7, lines 44-60). However, Sasano does not disclose, teach or suggest generating a first call from a first Primary Directory Number to a second Directory Number within a single BRI circuit.

Accordingly, even though Sasano may disclose data extraction from an incoming telephone message, Applicants submit that the Primary Directory Number call generation within

a single BRI circuit recited in independent claim 1 is patentably distinct from a user creating a roster of data entries by manually entering user information into a terminal, as disclosed in Sasano.

Claim 7, an apparatus claim corresponding to method claim 1, is believed similarly distinguished from Sasano.

Accordingly, Applicants submit that Sasano does not teach or suggest, and therefore does not anticipate nor render obvious, the invention as claimed. Applicants submit that independent claims 1 and 7 are thus patentably distinct from the cited reference for at least the stated reasons. Moreover, Applicants submit that claims 2, 8, 13 and 15, which are directly or indirectly dependent on amended independent claims 1 and 7, respectively, are also patentably distinct from Sasano for at least similar reasons. Therefore, Applicants request withdrawal of the rejections in view of Sasano.

Claim Rejections – 35 U.S.C. § 103

The remaining dependent claims have been rejected under 35 U.S.C. §103 as follows.

Claims 3-6, 9-12, 17 and 19 have been rejected under 35 U.S.C. §103(a), as being unpatentable over Sasano in view of Brown, et al. (U.S. Patent No. 5,600,654). Claim 14 has been rejected under 35 U.S.C. §103(a), as being unpatentable over Sasano in view of Johnson, et al. (U.S. Patent No. 6,141,406). Claim 16 has been rejected under 35 U.S.C. §103(a), as being unpatentable over Sasano in view of Hughes-Hartogs (U.S. Patent No. 5,854,829). Claim 18 has been rejected under 35 U.S.C. §103(a), as being unpatentable over Sasano in view of Brown, et al. and further in view of Johnson, et al. Claim 20 has been rejected under 35 U.S.C. §103(a), as being unpatentable over Sasano in view of Brown, et al. and further in view of Hughes-Hartogs. (See Office Action, ¶¶11-16, pages 6-10.) Applicants traverse these rejections.

Applicants respectfully submit that the pending claims are patentably distinct from the cited references, taken alone or in combination. More specifically, claims 3-6, 9-12, 14, and 16-20 are directly or indirectly dependent on independent claims 1 or 7, respectively. Accordingly, for at least the reasons discussed above with regard to independent claims 1 and 7 set forth above, Applicants submit the rejected dependent claims are also patentably distinct from the cited references taken either individually or in combination. Therefore, Applicants request withdrawal of these grounds of rejections.

Dependent Claims

Applicants have not independently addressed the rejections of the dependent claims because Applicants believe that, as the independent claims from which the dependent claims depend are allowable for at least those reasons discussed supra, the dependent claims are allowable for at least similar reasons. Applicants however, reserve the right to address such rejections should such be necessary.

Based on the foregoing, Applicants respectfully submit that the inventions as recited in the claims 1-20 as presented herein are neither anticipated by nor rendered obvious in view of, and are therefore allowable over, the art of record, taken alone or in combination and respectfully request that the respective rejections and objections be withdrawn.

CONCLUSION

It is now believed that all pending claims are in condition for allowance. In view of these amendments and remarks, an early and favorable reconsideration is respectfully requested.

The Examiner is invited to contact the undersigned at the telephone number below, should that in anyway facilitate prosecution.

While Applicants believe the petitioned one-month extension of time is sufficient for consideration of the foregoing Amendment and Response, should an additional extension of time be necessary to render this filing timely, such extension is hereby petitioned and the Commissioner is hereby authorized to charge any additional fees which may be required for this paper, or credit any overpayment, to Deposit Account No. 19-2179.

Respectfully submitted,

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